

REMARKS

The Official Action mailed June 18, 2002 has been received and its contents carefully noted. Filed concurrently herewith is a *Request for Continued Examination (RCE)*. This RCE is filed within two months of the filing date of the Notice of Appeal and therefore is believed to be timely without further extension of time.

Applicants note with appreciation the consideration of the Information Disclosure Statements filed on February 16, 1998; August 10, 1998; November 10, 1998; April 21, 1999; July 17, 2000; January 24, 2001; January 26, 2001; and July 31, 2001. However, Applicants have not received acknowledgement of the Information Disclosure Statement filed on May 20, 2002. Also, a further Information Disclosure Statement is submitted herewith and careful review and consideration of this Information Disclosure Statement is requested.

Pending claims 80-82, 84-88, 92-94, 98-100, 105, 108-110, 114-115, 118-120, and 132-153 have been canceled and new claims 154-186 have been added in this Preliminary Amendment. Thus, claims 154-186 are now pending in the present application, of which claims 154, 159, 164, 169, 175 and 181 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance.

New claims 154-186 recite a method for manufacturing a semiconductor device including a step of irradiating a semiconductor film with a laser light in an atmosphere containing oxygen. The presently claimed invention is supported by at least Example 7 and Fig. 4 of the present specification.

The Official Action rejects claims 80-82, 86-88, 104-105, 108-109 and 132-153 as obvious based on the combination of U.S. Patent 5,352,291 to Zhang et al. and JP 4-152624 to Satoshi. The Official Action further rejects claims 92-94, 98-100, 110, 114-115, and 118-120 as obvious based on the combination of Zhang and U.S. Patent 5,310,410 to Begin. Finally, the Official Action rejects claims 82, 85 and 88 as obvious based on Zhang alone. All claims have been canceled in favor of new claims 154-186 and thus these rejections are moot.

As stated in MPEP § 2143-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available

to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

It is respectfully submitted that Zhang, Satoshi and begin, taken alone or in combination, are insufficient to render the current claims obvious. Zhang in fact teaches away from the claimed invention because Zhang discloses that it is disadvantageous to irradiate the semiconductor film with the laser light in an atmosphere containing oxygen as described in column 3, lines 26-30. Specifically, Zhang states: "In the course of the crystallization taking advantage of the thus formed dangling bonds, it is very important to irradiate the laser beam in vacuum or in an inactive gas atmosphere, as mentioned earlier, because the exposure of the surface of the thus obtained semiconductor film to air causes bonding (neutralization) of the dangling bonds with oxygen, etc., to form an oxide film and the like on the surface of the film." Therefore, it is respectfully submitted that there is an insufficient basis to combine the teachings of Zhang, Satoshi and Begin to achieve the present invention and, even if properly combined, each and every limitation of the claims would not result. Favorable reconsideration is requested.

Conceal

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,


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